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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/039,955 | 10/24/2001 | Trevor Harms | 051373-0115 | 8428 |
| 59555 | 7590 | 08/10/2006 | EXAMINER | |
| RATHE PATENT & IP LAW 10611 W. HAWTHORNE FARMS LANE MEQUON, WI 53097 | | | REILLY, SEAN M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2153 | |

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/039,955 | HARMS ET AL. |
| | Examiner | Art Unit |
| | Sean Reilly | 2153 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 May 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-21 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Another Examiner has been assigned to this application.

This Office action is in response to Applicant's amendment and request for reconsideration filed on May 24, 2006. Claims 1-21 are presented for further examination.

Response to Arguments

1. Applicant's arguments are moot in view of the new grounds of rejection set forth.

Specification

5. Applicant's amendments to the specification as submitted on May 10, 2006 are accepted and entered into the record.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 12-15 and 21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**
3. With regard to claims 12-15 and 21, Applicant claims several "means for" limitations, which in view of the specification may all be implemented in software. Thus, the claim is software per se. A software program which is not tangibly embodied on a computer readable medium, is merely a manipulation of abstract ideas.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-13 and 15-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Tafoya et al. (U.S. Patent Number 6,829,607; hereinafter Tafoya).

With regard to claims 1, 16, and 21, Tafoya disclosed a method for populating a contact list (e.g. address book or resolution list) on a portable device (e.g. hand-held device, Col 5, lines 24-28), the method comprising:

- Extracting contact information from a number of messages stored in a memory in the portable device (e.g. initially populating the resolution list, see inter alia Col 7, lines 9-54); and
- Entering the extracted contact information into a contact list (e.g. address book or resolution list) maintained by a program operating on the portable device (see inter alia Col 7, lines 9-54) (for operating on the portable device see Col 5, lines 23-33).

With regard to claim 12, Tafoya disclosed a user interface configured to facilitate the populating of a contact list, the user interface comprising:

- Means for extracting contact information from a number of messages stored in a memory in the portable device (e.g. initially populating the resolution list, see inter alia Col 7, lines 9-54);
- Means for presenting the extracted contact information on the portable device (Col 2, lines 35-38);
- Means for receiving a number of selections of contacts to be stored in the contact list (e.g. user edits the list and then saves the list Col 2, lines 35-38);
- Means for entering the selected contact information into a contact list by a program operating on the portable device (saving the list Col 2, lines 35-38) (for operating on the portable device see Col 5, lines 23-33).

With regard to claims 2 and 17, Tafoya disclosed extracting contact information includes monitoring incoming messages and retrieving contact info information from incoming messages (dynamically update the resolution list, Col 9, lines 59-63).

With regard to claim 3, Tafoya disclosed contact information includes an SMTP email address (Col 7, line 51).

With regard to claims 4 and 18, Tafoya disclosed extracting contact information includes scanning a message database and retrieving contact information from messages contained in the database (e.g. initially populating the resolution list, see *inter alia* Col 7, lines 9-54).

With regard to claim 5, Tafoya disclosed only message sent or received before a preselected time (i.e. before the user closes the program), after a preslected time (e.g. after the user opens the program), or during a preselected time period are scanned (e.g. the system only scans the data store when the program is open, Col 9, lines 53-65).

With regard to claim 6, Tafoya disclosed only messages sent or received after a time of a last scan are scanned (i.e. after the program is started only new entries are dynamically scanned, Col 9, lines 61-63).

With regard to claims 7 and 19, Tafoya disclosed entering the extracted contact information into a contact list maintained by a program operating on the portable device includes providing a GUI with contact information configured to receive a selection from a user of the portable device (see *inter alia*, Col 11, lines 42-54).

With regard to claims 8, 15, and 20 Tafoya disclosed automatically entering in the contact list only contact information not already contained in the contact list (Col 10, lines 13-17).

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With regard to claims 9 and 10, Tafoya disclosed filtering contact information to include or exclude from the contact list contact information from emails and retrieved addresses received from certain domains (Col 11, lines 9-22).

With regard to claim 11, Tafoya disclosed filtering contact information to include in the contact list only email sender information (Col 8, lines 10-26).

With regard to claim 13, Tafoya disclosed means for presenting extracted contact information on the portable device includes means for providing a checklist of extracted contact information (e.g. the user is able to edit and delete entries in the list Col 2, lines 35-38).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tafoya.

Tafoya disclosed substantial features of the claimed invention however, Tafoya failed to specifically recite the portable device includes a display on a wireless application protocol (WAP) phone. Nonetheless Tafoya disclosed the invention may be practiced with other computer systems including hand-held devices. Further Examiner takes Official Notice that

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WAP phones were a widely known type of hand-held device in the art at the time of Applicant's invention. Thus, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement Tafoya's system in a WAP phone since 1) Tafoya disclosed his system may be practiced in other computer systems and 2) the WAP phone would provide users with more freedom by allowing them to roam wirelessly and thus communicate via phone and email from anywhere.

Conclusion

6. The prior art made of record, in PTO-892 form, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Reilly whose telephone number is 571-272-4228. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


August 7, 2006


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